

Remarks

Entry of the above noted amendments to the specification is respectfully requested prior to examination of the instant application. The amendments are made to include SEQ ID NO: identifiers on page 5 of the specification.

Summary of Restriction Requirement

The Restriction Requirement states that the Examiner has determined that 6 distinct inventions are contained in this application, namely:

- I Claims 1-3, 8, 9 and 16-19, drawn to a protein, classified in Class 530, subclass 350;
- II Claims 4, 6, 10, 11, 14 and 15, drawn to a gene encoding a protein and a vector, classified in Class 536, subclass 23.72;
- III Claim 5, drawing to a method for inducing apoptosis using a protein, classified in Class 435, subclass 91.33;
- IV Claim 7, drawn to a method for inducing apoptosis using a vector, classified in Class 435, subclass 320.1;
- V Claims 12, 20 and 21, drawn to a method for preventing or treating cancer of AIDS with a protein, classified in Class 530, subclass 300; or,
- VI Claim 13, drawn to a method for preventing or treating cancer of AIDS with a vector, classified in Class 435, subclass 320.1.

The Restriction has therefore required that an election be made between these inventions.

The Restriction also requires an election between the species of cancer or AIDS.

Election

In response to the Restriction Requirement, Applicants elect the invention of Group II (claims 4, 6, 10, 11, 14 and 15), with traverse. Further, Applicants elect the species AIDS. Applicants respectfully submit that at least claims 1-21 are generic, and at least claims 1-21 are readable on the elected species.

The Restriction Requirement is inappropriate.

Applicants respectfully submit that their application is a national stage under 35 U.S.C. §371 of PCT JP99/00388. Since this application is the national stage of a PCT application, unity of invention rules apply. However, the current restriction requirement appears to be based on restriction practice for applications filed under 35 U.S.C. §111, as opposed to the restriction practice for applications filed under 35 U.S.C. §371. In explaining the restriction, the Examiner cites MPEP §806.05(h) which sets forth the standard for restricting between product and process of using claims in cases filed under 35 U.S.C. §111. As mentioned previously, the present case was filed under 35 U.S.C. §371 and not 35 U.S.C. §111 and, therefore, the restriction is based on an incorrect standard.

MPEP §1850 provides that when the PTO considers international applications during the national stage under 35 U.S.C. §371, PCT Rules 13.1 and 13.2 will be followed when considering the unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. §111. According to PCT Rule 13.2, unity of invention exists when there is a technical relationship among the claimed inventions involving one or more technical features.

Additionally, the Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. 1.475 must be considered. Specifically, Applicants note that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

- (a) An international and a national stage application shall relate to one

invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Applicants point out that in determining unity of invention the criteria set forth in 37 C.F.R. 1.475 must be considered. Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking at least under 1.475(a) and (b). Therefore, the restriction requirement is improper for not discussing the various sections of 1.475.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on

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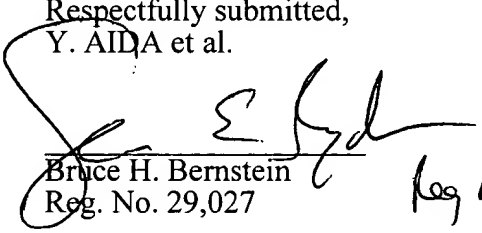
all of the claims pending in this application. In their regard, the pending claims should be considered to comply with unity of invention requirements. Of course, if the Examiner deems that unity of invention is not present, the Examiner is respectfully requested to set forth the basis for any holding of lack of unity of invention.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper in using the incorrect rules, and the requirement should be withdrawn.

Withdrawal of the requirement for the restriction with examination of all pending claims is respectfully requested.

Respectfully submitted,
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